

## **REMARKS**

Claims 22-70 are pending in the Application and all stand rejected in the Office action mailed September 26, 2008. Claims 22, 44, and 63 are amended by this response. Claims 22, 44, and 63 are independent claims from which claims 23-43, 45-62, and 64-70 depend, respectively. Applicants respectfully request reconsideration of the pending claims, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. §2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

## **Amendments to the Claims**

Applicants have amended claims 22, 44, and 63 to address antecedent issues. Applicants respectfully submit that no new matter is added by these amendments.

## **Rejection of Claims**

Claims 22-70 were rejected under 35 U.S.C. §112, second paragraph. Claims 22-32, 34, 36-41, 43-59, 61, and 62 were rejected under 35 U.S.C. 102(e) as being anticipated by Sharman (US H1641). Claims 33 and 60 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sharman in view of Rahnema (US 5,465,253). Claim 35 was rejected under 35 U.S.C. 103(a) as being unpatentable over Sharman in view of Baumert, et al. (US 5,392,281, hereinafter "Baumert"). Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Sharman in view of Endo (US 6,453,351). Claims 63-70 were rejected as being unpatentable under 35 U.S.C §103(a) over Sharman in view of Regnier (US 6,345,047). Applicants respectfully traverse the rejections.

### **I. Claims 22-70 Comply With 35 U.S.C. §112, 2<sup>nd</sup> Paragraph**

Claims 22-70 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. Applicants respectfully traverse the rejection, and believe that claims 22-70 are clear and definite. Nevertheless, Applicants have amended claims 22, 44, and 63 as shown above to correct noted minor typographical errors, submit that claims 22, 44, and 63, and any claims that depend therefrom, are in compliance with 35 U.S.C. §112, paragraph two, and respectfully request that the rejection of claims 22-70 under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

### **II. Sharman Does Not Anticipate Claims 22-32, 34, 36-41, 43-59, 61, And 62.**

Claims 22-32, 34, 36-41, 43-59, 61, and 62 were rejected under 35 U.S.C. 102(e) as being anticipated by Sharman (US H1641).

With regard to the anticipation rejections, MPEP 2131 states, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP 2131 also states, "[t]he identical invention must be shown in as complete detail

as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to independent claim 22, Applicants respectfully submit that claim 22 has been amended to recite “[a]n information transmission device for communicatively coupling at least one packet network to at least one communication network having an associated information format, the device comprising: at least one packet interface for exchanging information via the at least one packet network; at least one network interface, each of the at least one network interface for exchanging information via one of the at least one communication network in the associated information format; at least one converter for selectively converting information received by one of the at least one packet interface for transmission via one of the at least one network interface in the associated information format, and for selectively converting for transmission via the one of the at least one packet interface information received from the one of the at least one network interface in the associated format; and a host interface supporting the communication of status and control information between the information transmission device and a host device compatible with the host interface, the host interface permitting management of the information transmission device by the host device.” Applicants respectfully submit that Sharman does not teach each and every element of Applicants’ claim 22.

Initially, Applicants’ respectfully point out that Applicants’ claim 22 begins by reciting in the preamble three distinct and separate elements, namely, “[a]n information transmission device” that communicatively couples “at least one packet network” and “at least one communication network having an associated information format.” Thus, Applicants’ claim is drawn to an information transmission device that communicatively couples at least one packet network and at least one communication network.

The Office, however, asserts that Sharman teaches “an information transmission device (**network system, Fig. 1**) for communicatively coupling at least one packet network (**packet data network 108, Fig. 1**) to at least one communication network having an associated information format (**circuit switched network 103 , Fig. 1**),....” (emphasis in original) See Office action at p. 3. The Office clearly recognizes that Fig. 1

of Sharman teaches a “network system”, which Applicants’ respectfully submit is different from and does not teach or suggest an “information transmission device”, in accordance with Applicants’ claim 22, and its dependent claims. Further, Fig. 1 clearly shows that the “network system” of Sharman includes a number of elements such as, for example, “Fixed Telephone 124”, “Circuit Switched Network 103”, “Cellular Switch System 105”, and “Mobile End System 102”. The Office has failed to explain how a “network system” that includes, among other elements, a “circuit switched network”, teaches “an information transmission device” that communicatively couples “at least one packet network” to “at least one communication network having an associated information format.”

The Office, however, asserts that the entirety of Fig. 1 of Sharman teaches Applicants’ claimed “information transmission device”, and that the “packet data network 108” and “circuit switched network 103”, which are illustrated in Fig. 1 of Sharman as being a part of the cited teaching “network system”, teach the distinct and separate elements of Applicants’ claim 22 “at least one packet network” and “at least one communication network having an associated information format”. Applicants respectfully submit that Applicants’ claim 22 clearly discloses the separate and distinct claim elements “at least one packet network” and “at least one communication network...” as being “communicatively coupled by” the claimed “information transmission device” element of Applicants’ claim 22. Therefore, Applicants respectfully submit that teachings of Sharman that are alleged to teach Applicants’ separate and distinct elements “at least one packet network” and “at least one communication network...”, namely, the “packet data network 1208” and the “circuit switched network 103” are a part of and are not separate and distinct from the teaching of Sharman that is asserted by the Office to teach Applicants’ claimed “information transmission device”. Therefore, Applicants respectfully submit that the structure of the elements suggested by the Office does not meet the requirements of M.P.E.P. §2131, and that claim 22 is not anticipated by Sharman, for at least this reason.

Applicants respectfully note that to anticipate a claim, a reference must teach every element of the claim. See M.P.E.P. §2131. Further, “[t]he elements must be arranged as required by the claim, but this is not in *ipsissimis verbis* test, i.e., identity of

terminology is not required.” *Id.* Applicants respectfully submit that the cited teachings of Sharman cannot anticipate the presently claimed subject matter because, to the extent the elements of the presently claimed subject matter are disclosed by Sharman, Sharman does not disclose such elements being arranged as required by Applicants’ claim 22. For at least this reason, Applicants respectfully submit that the Office has not established a *prima facie* case of anticipation, as required by M.P.E.P. §2131.

In addition, the Office asserts that Sharman teaches “...a host interface supporting the communication of status and control information between the information transmission device and a host device, the host interface permitting management of the information transmission device by a host device compatible with the host interface **(packet protocol control 805 connects host computer 812 with the network system for controlling, sending and receiving data, Fig. 8 and Col . 7 Lines 60-63).** (emphasis in original) See Office action at p. 4. Applicants respectfully disagree.

Applicants respectfully note that the cited elements “packet protocol control 805” and “host computer 812” are shown to be part of Fig. 8 of Sharman, which is described at column 7, lines 39-40 as “...a block diagram of mobile end system 102...,” and that that “mobile end system 102” is a part of “network system” of Fig. 1, which the Office has identified as teaching Applicants’ claimed “information transmission device.” Further, Applicants’ claim 22 recites two separate and distinct elements “the information transmission device”, and “a host interface” that “...permit[s] management of the information transmission device” by a “host device”. Therefore, claim 22 recites that the “host device” is separate and distinct from the “information transmission device” of Applicants’ claim 22. The Office, however, is asserting that two elements, namely, the “packet protocol control 805” and “host computer 812”, which are both part of the “network system” of Fig. 1 of Sharman, teach Applicants’ claim elements “host interface” and “host device”. Applicants respectfully submit that Sharman does not teach both an “information transmission device” and a separate and distinct “host device”, in accordance with Applicants’ claim 22, and that the structural relationship of the asserted teachings of Sharman is not in agreement with that recited by Applicants’ claim 22, as required by M.P.E.P. §2131. Applicants therefore respectfully submit that Sharman

does not teach each and every element of Applicants' claim 22, for at least this additional reason.

Based at least upon the above, Applicants respectfully submit that the Office has not shown where Sharman teaches each and every element of Applicants' claim 22 as required by M.P.E.P. §2131, that the Office has not established a prima facie case of anticipation with respect to claim 22, and that Sharman fails to anticipate claim 22, and any claims that depend therefrom.

With regard to claim 25, Applicants respectfully submit that claim 25 is independently allowable over Sharman. The Office asserts, at page 4, that Sharman teaches "...wherein the information exchanged via the at least one packet interface comprises digitized voice information (**audio path switch connects packet data processor with audio processor and its attached speaker and microphone, Col. 7 Lines 52-54**)."

(emphasis in original)

Applicants respectfully disagree. Sharman states the following at column 7, lines 36-63, which includes the cited portion of Sharman at lines 52-54 (underlined):

Mobile end system 102 may select one or more of the available means of communication, depending on its configuration, availability of the desired network service, the cost of communication services, and user requests. FIG. 8 shows a block diagram of mobile end system 102. A cellular 40 radio 811 provides a single interface for both cellular circuit radio channel 119 and cellular packet radio channel 120. Signal processing and lower layer protocols required for the cellular interfaces are provided by a cellular circuit channel processor 808 and a cellular packet data channel processor 45 809. Interfaces to telephone access link 118 and local area network access link 121 are provided by a telephone access interface 801 and a local area network access interface 810, respectively. Switched circuit paths from telephone access interface 801 and cellular circuit channel processor 808 are 50 switched by an audio path switch 802, which connects either cellular circuit channel processor 808 or cellular packet data channel processor 809 to either an audio processor 803 and its attached speaker and microphone, shown as a handset 804, or to a modem and packet processor 807. Packet flow 55 to and from packet processor 807, telephone access interface 801, and local area network access link 121 is routed to a packet

protocol control 805, which performs higher layer protocol processing, for example according to TCP/IP specifications. A host computer 812 is connected to packet 60 protocol control 805 to control, send, and receive data. A mobile end system control 813 controls the operation of all components of mobile end system 102.

(emphasis added)

Applicants respectfully submit that there is nothing in the cited portion of Sharman shown above that even mentions “digitized voice”. Indeed, the whole of Sharman is silent with respect to “digitized voice”. Further, neither the cited portion of Sharman, nor any other text of figure of Sharman teaches where information exchanged via the “packet links 115, 117, 120, 121 of Fig. 2”, which were identified by the Office as teaching Applicants’ “at least one packet interface”, comprises “digitized voice information”, in accordance with claim 25. Therefore, Applicants respectfully submit that Sharman fails to teach each and every element of claim 25, that the Office has failed to establish a *prima facie* case of anticipation with respect to claim 25, that Sharman fails to anticipate claim 25, and that claim 25 is independently allowable over Sharman.

Further with regard to claim 30 Applicants respectfully submit that claim 30 is also independently allowable over Sharman. The Office asserts, at page 5, that Sharman teaches “...wherein the at least one converter converts digitized voice information into an analog voice signal, and an analog voice signal into digitized voice information (**modem 406, Col . 9 Lines 57-67**).” (emphasis in original) Applicants respectfully disagree. Initially, as discussed above with respect to claim 25, there is nothing in the entirety of Sharman that makes any mention of “digitized voice information.” Applicants now address the cited portion of Sharman at column 9, lines 57-67, which states:

Modem 406 converts data received over a data link 413 from a packet encoder 408 to an analog signal that is transmitted to circuit switch 407, and converts analog signals received from circuit switch 407 to data that is sent to a packet decoder 405 via a data link 414. Modem 406 may additionally include appropriate forward error correction, retransmission, and compression logic if desired. Many suitable modem devices with these capabilities are available,

with link layer protocols such as Microcom's MNP 4, MNP 5, and MNP 10 protocols, or the CCITT V.42 or V.42bis standards.

While the cited portion of Sharman shown above teaches that the “modem 406” converts data received over a data link to “an analog signal”, and converts “analog signals” received from a circuit switch to data that is sent to a packet encoder, the cited text from Sharman fails to disclose anything with regard to “digitized voice information”, as recited by Applicants’ claim 30. Applicants respectfully submit that the “analog signal(s)” taught in the cited portion of Sharman are “modem signals”, not “voice information”, and that any conversion that is performed by “modem 406” is the modulation and demodulation of “modem signals” from/to digital data. Applicants respectfully submit that there is nothing in either Fig. 4 or lines 57-67 of column 9 of Sharman that teaches at least this aspect of Applicants’ claim 30. Therefore, Applicants respectfully submit that the Office has failed to show that Sharman teach each and every element of claim 30 and has failed to establish a *prima facie* case of anticipation, and that claim 30 is independently allowable over Sharman.

With regard to claims 31 and 32, Applicants respectfully submit that claim 31 is also independently allowable over Sharman. The Office asserts, at page 5, that Sharman teaches “...wherein the at least one converter buffers digitized voice information for a predefined period of time to minimize gaps in an analog voice signal (**buffers 403 and 404, Fig . 4 and Col . 10 Lines 8-10**).” (emphasis in original) Applicants respectfully disagree. Initially, Applicants again respectfully submit that Sharman is silent with respect to “digitized voice information”, or the buffering of same. In addition, Applicants respectfully submit that “buffers 403 and 404” of Fig. 4 of Sharman are not a part of “modem 406”, which the Office has identified as teaching Applicants’ claim element “at least one converter”. Therefore, what the “buffers 403 and 404” may or may not do has no relevance to what the “modem 406” does or does not do. Therefore, any teachings of “buffers 403 and 404” of Sharman do not anticipate the “at least one converter” element of Applicants’ claim 31. Further yet, even if “buffers 403 and 404” were part of “modem 406” (which they are not), Applicants respectfully submit that Sharman fails to teach or suggest anything with respect to “minimizing gaps



in an analog voice signal”, or to “buffer[ing] digitized voice information for pre-determined period of time”, as recited by Applicants’ claim 31. Applicants now address the cited portion of Sharman at column 10, lines 9-10, shown below, in context:

Transmit buffer 403 stores **packet data** received from destination mobile packet router 210 over data link 218 until to it can be transmitted to mobile end system 102, or for a maximum time. The maximum time is determined by analysis of the data content of the data in the transmit buffer. As outlined here the packet data will conform to the Internet IP protocol, and **a maximum time to live is contained in these packet headers.**

(emphasis added)

The portion of Sharman shown above simply teaches that “buffer 403” stores packet data until it can be transmitted, or for a “maximum time”. Applicants note that the “maximum time” is a “maximum time to live”, which is described as a value contained in the headers of the “packet data”. Initially, Applicants respectfully submit that mere mention of “packet data” does not teach “digitized voice information”. Further, a “maximum time to live” does not teach a “pre-defined period of time” as in Applicants’ claim 31 feature “buffer[ing] digitized voice information for a predefined period of time”, in that a “maximum time to live” contained in a header of a data packet traveling over a “packet data network” (which does not inherently have a zero transit delay) does not result in buffering for a “pre-defined period of time”, but rather, results in packet data traveling through a packet network for up to a maximum amount of time. The amount of time in a “buffer” where the received packet is stored would vary depending on the amount of time taken to travel through the packet network, and would not be “pre-defined”. Therefore, Applicants respectfully submit that for at least the reasons set forth above, the cited portions of Sharman do not teach each and every element of Applicants’ claim 31, as required by M.P.E.P. §2131, that Sharman does not anticipate Applicants’ claim 31, and that claim 31, and claim 32 that depends therefrom, are independently allowable over Sharman.

With regard to claims 37, 39, and 41, Applicants respectfully submit that claims 37, 39, and 41 are also independently allowable over Sharman. The Office asserts, at

page 6, that Sharman teaches "...wherein the host interface supports the communication of information related to telephony signals received via the at least one network interface (**incoming indication, Col. 16 Lines 23-28**)...", as recited by Applicants' claim 37. The Office also asserts, at page 6, that Sharman teaches "...wherein the host interface supports the communication of information related to generation of telephony signals for transmission via the at least one network interface (**answer signal , Col 16 Lines 30-34**)...", as recited by claim 39. In addition, the Office asserts, at page 6, that Sharman teaches "...wherein the host interface supports exchange of voice messages for transmission via the at least one network interface (**host computer 812 sends and receives data , Col. 7 Lines 60-63**)...", as recited by claim 41. Applicants respectfully disagree. Applicants respectfully submit that, as previously shown with respect to claim 22, Sharman does not teach a "host interface", as recited by Applicants claims 37, 39, and 41. Therefore, Applicants respectfully submit that Sharman cannot teach each and every element of Applicants' claims 37, 39, and 41, as required by M.P.E.P. §2131, and that Sharman therefore does not anticipate claims 37, 39, and 41.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has not shown where Sharman teaches each and every element of Applicants claims 22, 25, 30-32, 37, 39, and 41, as required by M.P.E.P. §2131, that a *prima facie* case of anticipation has not been established, and that claims 22, and any claims that depend therefrom, are allowable over Sharman. Accordingly, Applicants respectfully request that the rejection of claims 22-32, 34, 36-41, and 43 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

With regard to independent claim 44, and its dependent claims 45-62, Applicants respectfully submit that claim 44 recites some of the same features, and is allowable over Sharman for at least some of the reasons set forth above with respect to the rejection of independent claim 22. Further, Applicants respectfully submit that Sharman does not teach "configuration information" as recited by Applicants' claim 44. The Office asserts, at page 7, that Sharman teaches "...receiving, from the host device,

configuration information based upon the at least a portion of the information requesting setup of a call (**answer signal, Col 16 Lines 30- 34**);....” (emphasis in original) Applicants respectfully disagree. Applicants now address cited column 16, lines 30-34 of Sharman, which state “...in block 909. It then sends an answer signalling packet from modem and packet processor 807 to the cellular circuit radio channel 119, to be subsequently communicated to mobile data switch 208, which signals answer supervision on....” Applicants respectfully submit that the Office fails to provide any explanation of how or why an “answer signal” teaches any of the elements of claim 44. Applicants respectfully submit that the Office has not shown how an “answer signaling packet” sent from a “modem” and “packet processor” to a “cellular circuit radio channel” teaches or suggests any of the features of Applicants’ claim 44, and therefore has not established a *prima facie* case of anticipation. Therefore, for at least these reasons, Applicants respectfully submit that Sharman does not anticipate Applicants’ claim 44, or any claims that depend therefrom. Further, Applicants respectfully submit that dependent claims 47, 57-59, and 61 recite features which are not anticipated by Sharman, as demonstrated above with respect to dependent claims of claim 22, and are independently allowable. Therefore, Applicants respectfully request that the rejection of claims 43-59, 61, and 62 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

### **III. The Proposed Combination Of Sharman And Rahnema Does Not Render Claims 33 And 60 Unpatentable**

Claims 33 and 60 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sharman in view of Rahnema. Applicants respectfully submit that claims 33 and 60 depend from independent claims 22 and 44, respectively. Applicants respectfully submit that claims 22 and 44 are allowable over the proposed combination of references, in that the Office has failed to show where Rahnema overcomes the shortcomings of Sharman, noted above. Because claims 22 and 44 are allowable over Sharman and Rahnema, Applicants respectfully submit that claims 33 and 60 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 33 and 60 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **IV. The Proposed Combination Of Sharman And Baumert Does Not Render Claim 35 Unpatentable**

Claim 35 was rejected under 35 U.S.C. 103(a) as being unpatentable over Sharman in view of Baumert. Applicants respectfully submit that claim 35 depends from independent claim 22. Applicants respectfully submit that claim 22 is allowable over the proposed combination of references, in that the Office has failed to show where Baumert overcomes the shortcomings of Sharman, as set forth above. Because claim 22 is allowable over Sharman and Baumert, Applicants respectfully submit that claim 35 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 35 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **V. The Proposed Combination Of Sharman And Endo Does Not Render Claim 42 Unpatentable**

Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Sharman in view of Endo. Applicants respectfully submit that claim 42 depends from independent claim 22. Applicants respectfully submit that claim 22 is allowable over the proposed combination of references, in that the Office has failed to show where Endo remedies the deficiencies of Sharman, discussed above. Because claim 22 is allowable over Sharman and Baumert, Applicants respectfully submit that claim 42 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 42 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **VI. The Proposed Combination Of Sharman And Regnier Does Not Render Claims 63-70 Unpatentable**

Claim 63-70 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sharman in view of Regnier. Applicants respectfully submit that independent claim 63 recites some elements also recited by independent claims 22 and 44. The Office supports the rejection of claim 63 citing portions of Sharman which Applicants have shown do not teach these elements. Applicants further respectfully submit that claim 63

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is allowable over the proposed combination of references, in that the Office has not shown how Regnier overcomes the relevant shortcomings of Sharman, set forth above. Further, Applicants believe that claim 69 is independently allowable, for at least the reasons set forth above with respect to claim 25. Accordingly, Applicants respectfully request that the rejection of claims 63-70 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **Conclusion**

In general, the Office Action makes various statements regarding the claims of the Application and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-70 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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